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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,407	11/24/2003	Fiorenzo Draghetti	20022/39780	4108
4743	7590	11/08/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,407

Applicant(s)

DRAGHETTI ET AL.

Examiner

Luan K. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/27/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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1. Claims 12-16 and 22-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/28/2005.

2. On page 3 of the specification, the phrases "as recited by claim 1" and "as recited by claim 22" should be deleted because those claims may not be existed during the prosecution of the application.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (5,823,350) in view of Focke et al. (5,586,648; hereinafter Focke'648). Ward discloses a method to detecting shoplifting by placing an electronic article surveillance sensor within a package to prevent the package from removing from the store unless the package is first purchased (see background of the invention). Ward further discloses a package (20) comprising a container containing batteries (22) and the electronic article surveillance sensor/marker (52) disposed within the package. The electronic article surveillance sensor/marker comprises all the limitations of the claims (column 3, lines 55-67). However, Ward fails to show the package containing a group of tobacco articles. Focke'648 shows a package comprising a container (10)

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containing a group of tobacco articles such as cigarettes. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Focke'648 to modify the package of Ward so the package containing a group of tobacco articles such as cigarettes to detecting the cigarettes package from being shoplifting.

As to claims 2-3, Ward discloses the maker disposed on a bottom piece and the piece attached to an inside surface of the container (Figures 1-3).

As to claims 4-9, Focke'648 shows a sheet of foil wrapping material (11) enclosing the group of tobacco articles, the container comprises an open top end (12), a lid (13) and a collar (38). With respect to the locations for the marker being disposed within the container, it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Ward as modified to attach the maker at any locations within the container such as the locations as claimed because the selection of the specific location to affix the marker would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well.

As to claims 17-21, see the details of the marker (52) (column 3, line 55 to column 4, line 10).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Boriani et al. (6,021,893; hereinafter Boriani'893. The package of Ward as modified further fails to show the group of tobacco articles being defined by a group of packets of cigarettes. Boriani'893 shows a package comprising a container (1) containing a group of packets of cigarettes. It would have been obvious to one having ordinary skill in the art in view of Boriani'893 to modify the package of Ward as

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modified so the group of tobacco articles comprises a group of packets of cigarettes to prevent the group of packets of cigarettes from being shoplifting.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Errica Miller at (571) 272-4370.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (571) 273-8300 for Formal papers and After Final communications.

lkb  
November 5, 2005



Luan K. Bui  
Primary Examiner